



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,614	12/05/2001	Hiroshi Kutsumi	MTS-3278US	2492

7590

09/26/2003.

Allen Ratner
Ratner & Prestia
One Westlakes Berwyn Suite 301
PO Box 980
Valley Forge, PA 19482-0980

EXAMINER

COBY, FRANTZ

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 09/26/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,614

Applicant(s)

KUTSUMI ET AL.

Examiner

Frantz Coby

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6-8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2171

This is in response to Application and Preliminary Amendment filed on December 05, 2001 in which claims 1-25 are presented for examination.

Status of Claims

Claims 1-25 are pending.

Information Disclosure Statement

1. The information disclosure statements filed on December 05, 2001; June 11, 2002 and July 13, 2003 are in compliance with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. They have been placed in the application and the information referred to therein has been considered as to the merits.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d) or (f), copies of the certified copies of the priority documents have been received which papers have been placed of record in the file.

Specification

2. The abstract of the disclosure is objected to because it recites legal phraseology often used in patent claims such as, means and comprising. Correction is required. See MPEP § 608.01(b).

3. Applicant is reminded of the proper content of an abstract of the disclosure.

Art Unit: 2171

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2171

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claim 1-2, 8-9, are rejected under 35 U.S.C. 102(e) as being anticipated by Sakurai U.S. Patent no. 6,130,962.

As per claim 1, Sakurai discloses “an information input means” (See Sakurai Figure 1, component 101); “a database” (See Sakurai Figure 1, component 103); “a search means” as a control unit which searches the mark database (See Sakurai Figure 1, component 2602; Abstract; Col. 2, lines 2-7); “an information display means” (See Sakurai Figure 1, component 104); “a selection means” See Sakurai Col. 13, lines 16-19); “an output means” as a display unit (See Sakurai Figure 1, component 104).

As per claim 2, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition Sakurai discloses “an information input means”; information display means”; “a selection means” and “an output means” integrally provided in the terminal device of

Art Unit: 2171

figure 1 of Sakurai. Further, Sakurai discloses the database and search means integrally provided in the management device of Sakurai (See figure 1, components 103 and 2603).

As per claim 8, all the limitations of this claim have been noted in the rejection of claim 1. It is therefore rejected as set forth above.

As per claim 9, most of the limitations of this claim have been noted in the rejection of claim 8. Applicant's attention is directed to the rejection of claim 8 above. In addition Sakurai discloses the aspect of searching based on a feeling or sensibility word since the databases of Sakurai searches data sets according to a degree to which respective contents match a content of the received retrieval information (See Sakurai Col. 2, lines 2-7).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 2171

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 3-7, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakurai U.S. Patent no. 6,130,962.

As per claim 3-5, most of the limitations of these claims have been noted in the rejection of claim 2. Applicant's attention is directed to the rejection of claim 2 above. In addition Sakurai discloses freely attachable and detachable recording medium as a computer readable medium (See Sakurai Col. 7, lines 18-20).

It is noted that Sakurai did not specifically detail the aspect of reading out contents stored in the recording medium when the recording medium is loaded or mounted in the supply device. However, one of ordinary skill in the art at the time of the invention would have found it obvious to store contents in a recording medium and load it to be read in the computer of Sakurai because that would have allowed useful and important information to be added or stored in the supply device of Sakurai.

As per claim 6, most of the limitations of this claim have been noted in the rejection of claims 3-5. Applicant's attention is directed to the rejection of claims 3-5 above. In addition Sakurai discloses a portable terminal device (See Sakurai Figure 2).

As per claim 7, most of the limitations of this claim have been noted in the rejection of claims 3-5. Applicant's attention is directed to the rejection of claims 3-5 above. In addition Sakurai discloses searching based on a feeling or sensibility word

Art Unit: 2171

since the databases of Sakurai searches data sets according to a degree to which respective contents match a content of the received retrieval information (See Sakurai Col. 2, lines 2-7).

As per claims 10-11, all the limitations of these claims have been noted in the rejection of claim 7. They are therefore rejected as set forth above.

10. Claims 12-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takashi Ikeda & Eiichiro Takana, "Hello Kitty Happy Mail and Enamail: two HTML software Products for the PC", NEC Report, Vol. 52, No. 4, April 23, (23.09.99), pp 79-81, photograph 3 and page 81 in view of Nikkeu Click, Vol. 6, No. 5, (Nichi), Nikkei BP sha, (08.04.99), page 58 and ASII, Vol. 22, No. 1, (Nichi), K.K. ASCII, (01.01.98), pp. 420-421).

As per claims 12-25, are unpatentable because Ikeda et al. discloses the feature wherein pictograph illustrations that are image data are synthesized with mail and sent (See Ikeda et al. photograph 3). Ikeda does not disclose text of more than two lines and two columns. On the other hand, Nikkei Click discloses text of more than two lines and two columns.

It would have been obvious to one of ordinary skill in the art at the time of the invention to replace the image data of Ikeda with text of more than two lines and two columns by the following the teachings of Nikkei Click because that would have enhanced the versatility of Ikeda's teachings by allowing data to be synthesized more efficiently.

Art Unit: 2171

As to the feature of selecting from a plurality of candidates, Neither Ikeda nor Nikkei Click disclosed selecting from a plurality of candidates. On the other hand, Nichi achieved the aforementioned limitation (See Nichi page 420, screens 1a-1c).

It would have been obvious to one of ordinary skill in the art at the time of the invention to achieve the aforementioned claimed feature by following the teachings of Nichi (See Nichi page 420, screens 1a-1c) because that would have further enhanced the versatility of Ikeda's teachings by allowing data to be synthesized more efficiently.

Conclusion

Any response to this action should be mailed to:

Commissioner of Patents and trademarks
Washington, D.C. 20231

or faxed to:

(703) 305-9051, (for formal communications
intended for entry)

Or:

(703) 308-5357 (for informal of draft
communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive,
Arlington.

VA., Sixth Floor (Receptionist).

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is (703) 305-4006. The examiner can normally be reached Monday through Friday from 9:00 A.M. to 5:00 P.M.

II. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-14367. The Fax phone number for this Group is (703) 746-7238; (703) 746-7239; (703) 746-7240.

Application/Control Number: 09/913,614

Page 9

Art Unit: 2171


FRANTZ COBY
PRIMARY EXAMINER

Technology Center 2171
September 20, 2003